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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,538	02/06/2004	Vincent L. Vaillancourt		6504

7590 09/17/2008
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EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
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3993

MAIL DATE	DELIVERY MODE
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09/17/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT L. VAILLANCOURT (DECEASED)
and
PATRICIA VAILLANCOURT,
Appellants

Appeal 2008-1523
Application 10/773,538¹
Technology Center 3700

Decided: September 17, 2008

Before CAROL A. SPIEGEL, DEMETRA J. MILLS, and ERIC GRIMES,
Administrative Patent Judges.

SPIEGEL, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants request rehearing of the DECISION ON APPEAL entered May 9, 2008 ("Decision"). The Decision affirmed the rejection of all pending claims, claims 2 and 3, as unpatentable under 35 U.S.C. § 103(a) over Wemmert (U.S. Patent 6,234,999 B1).

¹ Application 10/773,538 ("the 538 application"), *Needle Guard*, filed 6 February 2004 with a preliminary amendment, is said to be a divisional of application 10/116,776, filed 4 April 2002, now U.S. Patent 6,761,706, issued 13 July 2004, which claims benefit under 35 U.S.C. § 119 of provisional application 60/280,991, filed 4 April 2001.

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Having considered all the points that the Board is said to have misapprehended and/or overlooked in its Decision, we DENY rehearing of Appeal 2008-1523.

I. Discussion

According to Appellants, "The Decision Has Misapprehended Claim 2 in Light of the Findings of Fact [1-3 and 6]" (Request² 6).

A. Findings of fact 1 and 2

The subject matter of claim 2 relates to a needle assembly with a protective needle guard to prevent accidental needle pricks. Appellants submit that Findings of Fact ("FF") 1 and 2 in the Decision "are not in accord with Appellants' specification" (Request 1). Specifically, FF 1 and 2 found that Appellants' specification describes needle guards mounted on a needle cannula which can be moved from a first position where the sharp end of a needle is substantially enclosed, as illustrated by Figure 24, to a second position where the sharp end is exposed for use, as illustrated by Figure 27 (Decision 3). Appellants submit "Fig 27 represents the position of the housing 101 when the needle is in a patient, i.e. the 'first position', and Fig. 24 represents the position of the housing 101 after the needle has been withdrawn from the patient and the housing has been positioned over the end of the needle, i.e., the 'second position'" (Request 3).

Appellants' criticism of the Board's findings is unwarranted. Appellants apparently believe the Board was directly quoting the disclosure in Appellants' specification. It was not. Moreover, claim 2 neither recites a method claim nor moving a needle relative to a housing between a "first"

² Request for Rehearing filed 12 June 2008 ("Request").

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and "second" position. Thus, the Board's findings that Figure 24 represents a position where the sharp end of a needle is substantially enclosed in a housing, while Figure 27 represents a position where the sharp end is exposed for use is consistent with Appellants' explanation of what their specification discloses and is not inconsistent with the language of claim 2. Therefore, on this record, Appellants have not shown that FF 1 and 2 as set forth in the Decision at page 3 misapprehend and/or overlook the subject matter of claim 2 and/or the disclosure of 538 specification.

B. Finding of fact 3

Appellants submit "Fig. 24 represents the position of the safety needle housing 101 after the needle has been withdrawn from a patient. The needle cannot be reinserted through the lock 102 in the position illustrated" (Request 4).

The preliminary amendment filed February 6, 2004 stated (emphasis added):

Rewrite page 10, line 3 to page 11, line 11
as follows:

--Figs. 19, 20, 20A, 21, 22, 23, refer to the components of the safety needle assembly depicted in Figs. 24,25,26,27. The safety needle housing 101 shown in cross section consists of a generally tubular construction with an aperture 105 at one end and with the inner hollowed out portion 108 having two recesses 106 and 206. Into the first recess 106 is positioned the *stainless steel washer 102*. The *washer 102* outer diameter points 202 are slightly larger than the recess 106 diameter. The points 202 bite into the plastic wall creating an effective seal of the *washer 102* to the housing 101.

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The Mylar (polyester film) strip 110 is corrugated as shown in Fig. 27 and has a series of longitudinally spaced apart apertures 111 (Fig. 23). The end or first corrugation 221 is placed behind the *washer 102*, that is, between the face wall 104 of the housing 101 prior to locking the *washer 102* in place. The compressed corrugated Mylar strip 110 is placed within the housing 101. Just in front of the last corrugation is placed the hub locking washer 103. This washer 103 is placed in the rear recess 206 with the four cutouts of the washer 103 positioned over the four splines 107 of the safety needle housing 101. This washer 103 is pushed or otherwise positioned over the needle hub 20 splines 210 to form an interference fit between the washer 103 and the needle hub 20.

The filament of the washer 103 over the safety needle housing splines 107 is sufficient that the housing 101 may be gripped and used to wrench the needle hub 20 onto a male luer connector (not shown). The clearance between the washer 103 outer ring is such that when the safety needle housing 101 is moved forward, the housing 101 will readily separate from the washer 103 leaving the Mylar strip 110 connected to the needle hub 20.

As the safety needle housing 101 moves down the needle 12 axis, the Mylar strip 110 unfolds about the needle 12 until it reaches its [*sic*, its] maximum extension. The Mylar strip's 110 length is such that the housing 101 will enclose the sharpened end of the needle 12 before full extension is obtained. When full extension of the Mylar strip 110 is obtained and the needle 12 is totally within the safety needle housing 101, the user releases the housing 101. At that time there is some retraction of the Mylar strip 110 pushing the needle 12 sharpened point against the *"H"shaped*

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lock 102. This **lock 102** is initially flexed 204 inwardly by the movement of the needle 12 in the proximal direction through the housing 101.

When the needle 12 is retracted into the housing 101 the washer flaps 241 close and regain their initial shape. The "**H**" **section 102** is prevented from moving in the opposite direction (outward) by the front wall of the housing 101 which interferes with any potential movement of the flaps 241.--

Initially, we note that the 538 specification defines element 102 as a generic stainless steel washer, then as an H-shaped lock, and finally as an H-shaped lock with flaps.

Appellants' criticism of FF 3 is not commensurate with the claimed invention. Claim 2 does not require a washer, let alone a particular type of washer, e.g., H-shaped with flaps. It is improper to read limitations from the specification into the claims. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988) ("particular embodiments and examples appearing in the specification will not generally be read into the claims"); *In re Hiniker Co.*, 150 F.3d 1362, 1368 (Fed. Cir. 1998) ("Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims.").

Therefore, on this record, Appellants have not shown that FF 3 as set forth in the Decision at page 3 misapprehends and/or overlooks the subject matter of claim 2 and/or the disclosure of the 538 application.

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C. Finding of fact 6

Appellants submit "[t]he term 'stretched' is not used in Wemmert" (Request 4). Appellants further submit "[t]here is no description in Wemmert that the tether 44 is 'stretched' between the hub 34 and the shield 40" (Request 5).

The fact that Wemmert does not explicitly use the word "stretched" in its disclosure does not mean that Wemmert does not disclose "stretched" as the term is recited in claim 2. Indeed, Appellants do not contend that the Board overlooked, misapprehended or failed to appreciate an expressly narrowing definition of the term "stretched" in the 538 specification. As noted in the Decision at page 6, claims in an application are to be given their broadest reasonable interpretation consistent with the underlying specification. *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). The ordinary meaning of "stretch" encompasses "extend." For example, according to WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY (1984) at page 1166, "stretch" is defined, in part, as

1: to extend . . . in a reclining position **2:** to reach out: EXTEND . . . **3:** to extend in length . . . **7:** to pull taut . . . **8 a:** to enlarge or distend esp. by force . . . **b** to extend or expand as if by physical force . . . **9:** to cause to reach or continue (as from one point to another or across a space) . . .

Thus, while Wemmert may not have expressly used the term "stretch" in its disclosure, the disclosure describes "stretching" as that term is commonly understood. Furthermore, as noted in the Decision at pages 4-6, Appellants' specification exemplifies a Mylar plastic strip (FF 5). Mylar is a biaxially-oriented polyethylene terephthalate film (Decision 4, n. 5), and Wemmert

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discloses a tether preferably made of a polyethylene terephthalate (FF 7).

Therefore, on this record, Appellants have not shown that FF 6 as set forth in the Decision at page 5 misapprehends and/or overlooks the subject matter of claim 2 and/or the disclosure of Wemmert and/or the 538 application

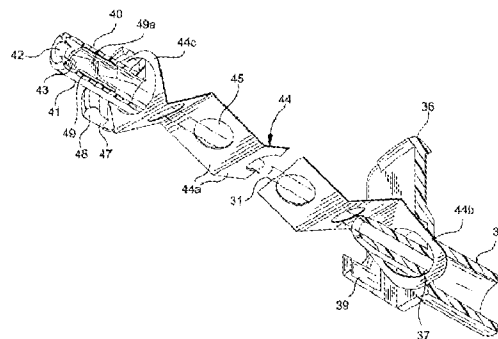
D. Claim 2

Claim 2 recites a combination comprising, in relevant part (emphasis added),

a polyester film strip secured to and between said hub and said housing, said strip having a series of longitudinally spaced apart apertures receiving said needle therein and being disposed in corrugated relation between said hub and said housing whereby in response to a withdrawal movement of said needle relative to said housing, said needle moves into said housing and into abutment with said housing while said strip is stretched between said hub and said housing to retain said housing connected to said hub under a biasing force.

Figure 6 of Wemmert was relied on in the Decision at page 5 and is reproduced below.

FIG. 6



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{Fig. 6 of Wemmert shows a needle assembly comprising a needle extending at one end from a hub with its other, sharp end enclosed inside a movable housing which is connected to the hub by a corrugated plastic strip.}

Appellants submit "there is no teaching in Wemmert that the shield 40 is connected to the needle hub 34 under a biasing force or that the tether 44 is stretched to retain the shield 40 connected to the hub 34 under a biasing force while the needle 31 is in abutment with the shield 40" (Request 7).

As seen in Wemmert Figure 6, "[t]he tether 44 is a relatively stiff but flexible material, preferably polyethylene terephthalate, a polyester, which 'provides a slight biasing force to help maintain tether 44 in the completely extended position . . . [which] aids in maintaining needle shield 40 in position over the sharp distal tip of . . . [the] needle 31' (Wemmert 6:37-45)" (Decision FF 7). The 538 specification does not define "a biasing force." Claim 2 does not require "a biasing force" in any particular direction. Claim 2 requires that the polyester film is capable of being stretched, i.e., extended in length. Wemmert states "tether **44** has a length that maintains the sharp distal tip of introducer needle **31** in main body portion **41** of needle shield when tether **44** is fully extended" (Wemmert 5:65-6:1); and "[a]gain, tether **44** maintains main body portion **41** in the proper location so that the sharp distal tip of introducer needle **31** is safely located within main body portion **41** of needle shield **40**" (Wemmert 6:20-24). In other words, tether 44 aids in maintaining shield 40 in abutment, i.e., contact, with needle 31 (sharp distal tip) while stretched, i.e., extended, between hub 34 and housing 40 with a slight biasing force. Thus, giving claim 2 its broadest reasonable interpretation consistent with its supporting disclosure, we find no structural

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distinction between a combination within the scope of appealed claim 2 and the needle assembly combination fairly described by Wemmert.

E. Summary

In summary, Appellants have not shown that we misapprehended or overlooked any points in the Decision. The request for rehearing is denied.

II. Order

Having considered Appellants' Request for Rehearing, filed June 12, 2008, and all the points Appellants allege the Board has overlooked and/or misapprehended in its original decision in Appeal 2008-1523, mailed May 9, 2008, and for the reasons stated herein, it is

ORDERED that the request for rehearing of Appeal 2008-1523 is
DENIED.

REHEARING DENIED

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